

REMARKS

This amendment is submitted in response to the Office Action mailed July 29, 2005. In the Office Action, the U.S. Patent and Trademark Office (hereinafter "the Office") rejected Claims 2-16 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Herold (EP 0098474) in view of patents to Powell et al. (US 6,612,073), Farkas (US 4,614,056), Watson (GB 2,173,984), Mills (US 3,686,791), and Lee (US 5,440,836). Applicant has carefully considered the cited art and the commentary provided in the Office Action, and respectfully requests reconsideration of the application for the reasons discussed below.

Claims 2-16 and 21 are pending and have not been amended. New Claim 22 has been added. Applicant submits that the claims in the present application are patentable over the cited art and should be allowed.

Claim 21

Claim 21 was rejected as being unpatentable over Herold in view of Powell et al. The Office Action described the basis for the claim rejection as follows:

For claim 21, Herold teaches in figs. 3-6 a stackable planter, comprising: a plurality of planter trays 12,13, each planter tray having an annular inner rib 19,19a defining a center portion of the planter tray; wherein the center portion of at least one planter tray has an aperture (the top planter tray 13) extending through the bottom of the planter tray; wherein the center portion of at least one other planter tray (the bottom planter tray at bottom of ref. 15) has a bottom wall extending across the center portion of the planter tray; and wherein each of the annular inner ribs of the planter trays have the same shape allowing the planter trays to be stacked in an interchangeable order, such that when stacked, the annular inner ribs of

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the planter trays define a center portion of the stackable planter having a variable amount of volume, the depth of the center portion of the stackable planter depending on the location in the stackable planter of a planter tray with a bottom wall, whereby one or more plants can be planted in the center portion of the stackable planter (note, the structure of refs. 15,15a can or capable of containing plants if soil and plants were to be planted).

The Office Action further cites to Powell et al. for teaching a stackable planter comprising a plurality of planter trays having at least one planter cup 64 at a periphery.

Applicant has reviewed the cited references and submits that the Office has erred in rejecting Claim 21 as being obvious in view of Herold and Powell et al. It is axiomatic in the law that to establish *prima facie* obviousness of a claimed invention, all of the limitations of a claim must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). *See also* M.P.E.P. § 2143.03.

Applicant submits that the disclosure of Herold is deficient with regard to Claim 21 and the disclosure of Powell et al. does not overcome the deficiencies of Herold. Herold teaches an arrangement for the holding of plants in large office rooms, banks, and the like. The arrangement includes a closed system forming a plant column, consisting of a hollow base container, with story-like containers placed one on top of the other. The arrangement further includes laterally placed plant containers, and a water fill basin together with an arrangement for the delivery of water to the plant containers by way of the plant sub-strata and hydro-fertilizing between the different levels of the plant containers. The intermediate tray levels are placed in such a manner that water is delivered to each tray from top to bottom. Each is placed in such a

way that water can flow from one level to the next by way of a connecting passage. *See, e.g.,* Figures 3-6 and Claim 1 of Herold.

In applying Herold to Claim 21 of the present application, the Office points to the planter tray 13 as constituting the planter tray having a central portion with an aperture extending through the bottom of the planter tray, and points to tray 12 as constituting the planter tray with a bottom wall extending across the center portion of the planter tray. A review of Herold, however, shows that the planter trays 12, 13 are not configured “to be stacked in an interchangeable order,” as claimed in Claim 21.

Herold provides no teaching or suggestion of which applicant is aware that trays 12 and 13 are interchangeable in the order in which they are stacked. By their configuration, tray 12 is always on the bottom and tray 13 sits on top of tray 12. Even if one were to interchange the order and stack tray 12 on top of tray 13 (which applicant specifically denies), the result is a stacked planter that is unstable, undesirable, and contrary to the express teachings of Herold. Having planter tray 13 on the bottom would force the stacked planter to stand on a narrow base pedestal provided by center column 15a. Further, if tray 12 were placed on top of tray 13, tray 12 would easily slide off. Such a configuration is untenable and is not taught or suggested by Herold. To reconfigure the trays 12, 13 to make them truly interchangeable would require substantial experimentation and, indeed, either inventive effort or hindsight review of the present application.

In contrast, the planter trays in the present application have annular inner ribs with the same shape allowing the planter trays to be stacked in an interchangeable order, such that when stacked, the annular inner ribs of the planter trays define a center portion of the stackable planter having a variable amount of volume. The depth of the center portion of the stackable planter depends on the location in the stackable planter of a planter tray with a bottom wall.

Nowhere does Herold suggest the combination set forth in Claim 21, nor is there any disclosure or motivation supporting a modification of Herold to achieve the claimed invention in either Powell et al. or the other secondary references to Farkas, Watson, Mills, or Lee.

Applicant respectfully submits that the disclosures of Herold and Powell et al. are deficient with regard to Claim 21. Because the Office has not established a *prima facie* case of obviousness of the claimed invention, the Office is asked to withdraw the rejection of Claim 21 and allow it to issue.

Claims 2-16 and 22

Applicant respectfully submits that Claims 2-16 and 22 are patentable for their dependence on allowable Claim 21. *See In Re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988) (if an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious).

Applicant further submits that Claims 2-16 and 22 are patentable for the additional subject matter recited therein. For example, Claim 4 recites that a planter tray is configured to nest within a second planter tray while in a collapsed condition. The Office Action refers to Powell et al. for its teaching of nesting trays. However, it is not readily apparent how the teaching of Powell et al. would be combined with Herold. The planter trays taught by Herold have a very specific configuration that, if modified to permit nesting of the planter trays, would eviscerate the particular features taught by Herold. Further, as indicated above, such a reconfiguration of the planter taught by Herold would require substantial experimentation and, indeed, inventive effort.

As another example, Claim 7 recites the stackable planter having an engagement mechanism configured to secure the plurality of planter trays in a terraced configuration. However, Herold does not teach that trays 12, 13 could be terraced in the manner taught and

claimed in the present application. *See, e.g.*, FIGURES 23, 24, and 30 of the present application and the related discussion of terraced configurations provided at page 9, lines 6-25, of the application.

Applicant respectfully submits that Claims 2-16 and 22 are patentable and should be allowed.

CONCLUSION

The application is in condition for immediate allowance. Reconsideration of the application and allowance of the claims at an early date is requested. Should any matters need resolution prior to allowance of the application, the Office is invited to contact applicant's attorney at the telephone number indicated below.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the below date.

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